

- 3) Determine the level of skill of artisans in the pertinent art. The inventor, Allan Todd Berry, has more than 20 years of experience working in the chicken process industry (See Rule 132 Affidavit of Allan Todd Berry, previously filed) and is well qualified to provide an opinion in this matter.
- 4) Against this background, determine the obviousness or un-obviousness of the inventive subject matter. In making this determination, one should evaluate the invention as a whole. The invention must be considered as a whole. Rockwell Int'l Corp. v. United States, 147 F. 3d 1358 (Fed. Cir. 1998)
- 5) Finally, one must consider secondary and objective factors such as commercial success, long felt but unsolved need and failure of others. Importantly, the Federal Circuit has instructed that these secondary considerations and objective factors must be considered in every case, both by the courts and PTO. Custom Accessories, Inc. v. Jeffrey-Allan Industries, Inc., 807 F. 2d 955 (Fed. Cir. 1986) (emphasis supplied).

First, one must consider the scope and content of the prior art. One reference is to U.S. Patent No. 3,781,946 to Altenpohl. That patent is for a “poultry shackle suspension invention.” However, Applicant’s invention is for a “process to electronically automate the sorting of chicken feet in the category of edible or inedible.” It is questionable as to whether the patent to Altenpohl should be even considered prior art. See, In re Clay, 966 F. 2d 656 (Fed Cir. 1992). But, assuming for discussion, that it is, the Patent Office cites Altenpohl to make reference to a “flag” that is attached to a shackle. A flag is, according

to Merriam Webster's Collegiate Dictionary, Tenth Edition, “a rectangular piece of fabric of distinctive design that is used as a symbol (as of a nation), as a signaling device, or as a decoration.” Altenpohl does not employ a flag in his invention. Item 14 of Altenpohl depicts an upper post portion of a shackle body and item 16 is a suspension assembly. There is simply not a flag (as defined in Webster and used in Applicant’s invention) depicted in Altenpohl. In fact, a review of Altenpohl reveals that there are no elements of Applicant’s invention present. So, Altenpohl should not be considered prior art.

U. S Patent No. 6,254,472 to Meyn, at a minimum, does not depict electronic sensors, flags, an inspection button, and a means to interface an inspection station to a programmable means.

U. S Patent No. 4,150,374 to Brook, at a minimum, does not depict flags, an inspection button, a programmable communication card and a means to interface to an inspection station to a programmable means.

U.S. Patent Application 2003/0139130A1 to Steffler, at a minimum, does not depict the flags and the inspection button interfacing with a programmable means.

U.S. Patent Application 2003/0065414 to van den Nieuwelaar et al. is only cited to depict an inspection station that interfaces with a programmable means.

Second, one must determine the novelty of Applicant’s invention. In this matter, as one can see from the above recitation of the patents or patent applications cited, no one patent or patent application cited by the PTO depicts all the major elements of the current invention as disclosed and claimed.

Third, one must determine the level of skill of artisans in the pertinent art. The inventor, Allan Todd Berry, has more than 20 years of experience working in the chicken

process industry (See Rule 132 Affidavit of Allan Todd Berry, previously filed) and is well qualified to provide an opinion in this matter. The prior art references must suggest to the skilled artisan that they can be combined and that combination would have a reasonable probability of success. See, Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F. 3d 1568 (Fed.Cir. 1996). In this case, there is no suggestion in the prior art to combine these patents or patent applications, and it is Applicant's opinion, based on his knowledge and skill in the industry, and that level of skill in the pertinent art, it would not lead one to combine all of these patents and patent applications cited by the Patent Office. (See, Rule 132 Second Affidavit of Allan Todd Berry). Care must be taken to avoid hindsight reconstruction by using a patent application as a guide to combine a maze of prior art references and combine them in the right way so as to achieve the result of obviousness. See, Grain Processing Corp. v. American Maize-Products Co., 840 F. 2d 902 (Fed. Cir. 1988).

Fourth, against this background, one must determine the obviousness or unobviousness of the inventive subject matter. In making this determination, one should evaluate the invention as a whole. The invention must be considered as a whole. Rockwell Int'l Corp. v. United States, 147 F. 3d 1358 (Fed. Cir.1998). When one considers the invention as a whole, one determines that no one patent or patent application contains all the elements claimed in Applicant's invention. Further, none of the patents or patent applications depict a flag connected to a shackle, and a person must combine at least 2 patents and 2 patent applications to depict many of the other major elements of Applicant's invention. Further, one skilled in this art would not, based on Applicant's opinion, combine all of these patents and applications to create such an

invention. It was only through Applicant's efforts and skill that he invented his invention which is non-obvious to one skilled in this art. (See, Rule 132 Second Affidavit of Allan Todd Berry).

Finally, one must consider secondary and objective factors such as commercial success, long felt but unsolved need and failure of others. Importantly, the Federal Circuit has instructed that these secondary considerations and objective factors must be considered in every case, both by the courts and PTO. Custom Accessories, Inc. v. Jeffrey-Allan Industries, Inc., 807 F. 2d 955 (Fed. Cir. 1986) (emphasis supplied). The relevant evidence on the obviousness vs. non-obviousness issue, the Court, even in Graham, said, and as other courts have emphasized, it must include evidence on secondary considerations and it is error to exclude that evidence from consideration. See, Stratoflex, Inc. v. Aeroquip Corp., 713 F. 2d 1530 (1983).

In regard to commercial success, Allan Todd Berry states, in part, in his Second Affidavit as follows:

"I have attached hereto a summary sheet of the customers using my invention with associated invoice amounts, and a true and correct copy of the invoices submitted to the customers which are using my invention which is described in my patent application. They are marked as Exhibits 1 and 2, respectively. The invoices are for the purchase of my invention, as such features are claimed and are as described in my patent application, and such invoices are true and correct copies of the invoices sent to the respective customers and are business records which are kept in the ordinary course of business.

My invention, in its unique combination, as described in the patent application and as claimed in my patent application, is a commercial success. It is currently used in production by many customers. Those customers are identified in Exhibits 1 and 2. The invoices total more than \$1.8 million dollars. With over \$1.8 million in sales of my invention, my invention, as the features recited in the claims, is a commercial success." (emphasis supplied).

In further response to the obvious vs. un-obvious issue, in this matter, this is not a mere substitution of one element for another to come up with a new invention like in Hotchkiss v. Greenwood, 52 U.S. 248 (1850). The Applicant, with respect to his invention, developed a wholly new process and invention which, as a whole, is not disclosed by any one patent or patent application cited by the PTO.

With respect to Applicant's invention, the combination he created is a new invention with such combination, as a whole, not reading on another patent or patent application. Further, unlike in Graham, Applicant's invention is not a mere modification of an existing device (where Graham merely reversed the shank and hinge plate's position to create a new invention which was held to be obvious). Applicant has provided a new method as a whole in his invention which is un-obvious to one skilled in this art.

There is no one patent or patent application cited that cites all the elements listed in Applicant's disclosure and the newly written claim(s).

The Patent and Trademark Office has to combine, in some cases, four patents (or applications) in order to try to show obviousness. The need to combine so many patents (or applications), by definition, shows un-obviousness, rather than obviousness. The more prior art documents needed to try to depict obviousness proves that the invention is un-obvious.

As previously stated and is part of the file, *the current invention is being adopted by others and is recognized in the field as setting a standard in its combination of elements* (See, Rule 132 Affidavit of Allan Todd Berry, previously filed). This is evidence of un-obviousness according to the Grahman case.

Conclusion

For all the foregoing reasons, Applicant submits that the specification, drawings, and claim(s) are now in proper form, and that the claims all define patentably over the prior art. Therefore, Applicant submits that his patent application is now in condition for allowance, which action he respectively requests.

Very Respectively,



Joseph G. Mitchell
Title : Patent Attorney
PTO # 40,730
Address:
4521 Derby Lane
Smyrna, GA 30082
Phone : 404-943-2981
e-mail: joeymitch@earthlink.net

Dated : 8-2-2005